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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			THOMPSON, MICHAEL M	
ART UNIT		PAPER NUMBER		3629
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/019,672	EBERT, PETER STEFFEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael M. Thompson	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 June 2010.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-52 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-52 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term “symbol” is not found in Applicant's disclosure.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define “things” or “products”, while a “process” consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *Bilski v. Kappos*, 561 U.S. \_\_\_\_ (2010).

Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent precedent from the Supreme Court from in *Bilski v. Kappos*, the machine-or-transformation test is a helpful two-branched inquiry; an applicant may show that a process claim satisfies §

101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

**Claims 1-13** are drawn to a method for defining and identifying geographic areas. To qualify as a statutory process, the claim should positively recite in the body of the claim, the machine to which it is tied. For example, by identifying the machine that accomplishes the method steps, or positively reciting the article that is being transformed. The claims are not tied to a particular machine as newly amended as the preamble merely states "when executed by the processor" and does not specifically recite that the steps must be executed by a processor or that all steps are executed by a processor. Furthermore, it is further unclear if all of the steps are must be executed by a processor or if some steps are excluded.

Please note that ***nominal recitations of a machine in an otherwise ineligible method fail to make the method a statutory process***. See Benson, 409 U.S. at 70 - 72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject

matter." Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, and other forms of insignificant extra solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of involvement of a machine or transformation in a method claim do not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (2008) and *Bilski v. Kappos*, (U.S. 2010).

Therefore, the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and Applicants' claim here appears to fail this test. No new matter should be added.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-3, 5-7, 14-16, 18-20, 27-29, 31-33, 40-42 and 44-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Cossins et al. (US 6,343,290).**

6. **With respect to claims 1, 14, 27 and 40:**

Cossins et al. teaches a method for defining and identifying geographic areas performed by a computer system comprising a processor, a display device, and a memory encoded with program instructions that, when executed by the processor cause the processor to perform the method, the method comprising the steps of:

providing for a geographic region wherein the geographic region is divided into subregions that are mutually exclusive, and wherein the subregions are divided into sections that are mutually exclusive (i.e. at least via the maps in the figures and description of regions at col. 17 and col. 21; it could also be considered together or separately as the coverage areas as described in col. 15; this may similarly be described by data alone as in the case with regions by zip code at col. 20 and 23, geocode, *passim*);

receiving a query for defining a geographic area wherein the query comprises an indication of at least one of a set of subregions and a set of sections (i.e. via at least col. 15 line 64 through col. 16 line or geocode searches specific to the "regions", *passim*), wherein the indication comprises at least one symbol associated with at least one of reducing the number of subregions within the set of subregions, and reducing the number of sections with the set of sections (i.e. via at least col. 5 and 16 for the proposition that the generated maps have map based geographic elements such as stream "264" and/or network elements and/or performance elements, and/or geographic elements of the telecommunication system as shown in the Figures, for the proposition that any one of these elements contain "symbols" as the map is rendered);

determining whether the reference to at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be included in the geographic area (i.e. at a minimum, inherent via the search or query feature when the user inputs a search criteria and the search feature of the invention determines the region being searched for as described and renders the appropriate map based on the search criteria, *passim*);

determining whether the reference to the at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be excluded from the geographic area (i.e. at a minimum, inherently via a query or search in when a search or query attempts to determine and render the appropriate map based on the search it inherently fails to find a match for the regions not included in the search criteria, *passim*. In short, when a search criteria is submitted these steps of "determining" will occur simultaneously to include the region searched for and exclude the regions considered not to be within the criteria sought);

and outputting, on a display device, a response including information relating to the geographic area wherein the geographic area is representative of the query (i.e. via the map generation of the search query results, col. 15 and col. 16).

**1. With respect to claims 2, 15, 28 and 41:**

Cossins et al. teaches the method of claims 1, 14, 27 and 40 respectively, wherein the subregions are states and the sections are postal codes (i.e. via at least at col. 20 lines 1-36, *passim* for the proposition that there are various descriptions of searching by state or postal code which represent query collections).

**2. With respect to claims 3, 16, 29, 42:**

Cossins et al. teaches the method of claims 2, 15, 28 and 41 respectively, wherein sections can be identified by at least one number included in the postal code, starting with the first number of the postal code (i.e. via at least a similar rejection as that of claims 2, 15, 28 and 41 wherein the postal code has at least one number associated with one number).

**3. With respect to claims 5, 18, 31 and 44:**

Cossins et al. teaches the method of claims 1, 14, 27 and 40 respectively, wherein outputting the response one a display device further includes:

incorporating in the response a pictorial diagram of the geographic area (i.e. via the map generation, Figures, *passim*);

and depicting the subregions and sections that are included in the geographic region in a different manner than the subregions and sections that are excluded from geographic area (i.e. via the several interpretations such as coverage area regions at col. 15, lines 17-27; Figures 37-39 with descriptions; and/or col. 10 lines 57- col. 11, line 4, *passim*, for the proposition that color representation is discussed throughout).

**4. With respect to claims 6, 19, 32 and 45:**

Cossins et al. teaches the method of claims 5, 18, 31 and 44 respectively, wherein depicting the subregions and sections further includes denoting the subregions and sections included in the geographic area in a different color than the subregions and sections that are excluded from the geographic area (i.e. via the several interpretations such as coverage area regions at col. 15, lines 17-27; Figures 37-39 with

descriptions for different shades of grey; and/or col. 10 lines 57- col. 11, line 4, *passim*, for the proposition that color representation is discussed throughout).

**5. With respect to claims 7, 20, 33 and 46:**

Cossins et al. teaches the method of claims 5, 18, 31 and 44 respectively, wherein depicting the subregions and sections further includes denoting the subregions and sections included in the geographic area in a different shading than the subregions and sections that are excluded from the geographic area(i.e. via the several interpretations such as coverage area regions at col. 15, lines 17-27; Figures 37-39 with descriptions denoting different shades of grey; and/or col. 10 lines 57- col. 11, line 4, *passim*, for the proposition that color representation is discussed throughout).

***Claim Rejections - 35 USC § 103***

**6.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 4, 8-13, 17, 21-26, 30, 34-39, 43, and 47-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cossins et al. in view of Metacrawler Query Submission (05/18/1997; hereinafter “Meta”) and/or the Quick Reference Guide to Search Engine Syntax (04/07/2001; hereinafter “Guide”).**

**8. With respect to claims 4, 17, 30 and 43:**

Cossins et al. teaches the method of claims 1, 14, 27 and 40 respectively, and the use of search query to identify regions in a geographic area, except for explicitly reciting the receiving a query includes:

incorporating in the query a plus sign to add at least one of a subregion contained in the set of subregions and a section contained in the set of sections to the geographic area;

and incorporating in the query a minus sign to exclude at least one of a subregion contained in the set of subregions and a section contained in the set of sections to the geographic area.

However, Meta and Guide both teach search engine or search query syntax where common search syntax terms such as "and" or "not" are used interchangeably with a "plus sign" or a "minus sign" and are common to search term syntax when attempting to search for terms and exclude terms from a search. For example Meta teaches "THE PLUS SIGN: + A plus sign to designates a word that must be present in the document..." and "THE MINUS SIGN: - A minus sign designates a word that must not be present in the document." This is similarly taught and excepted in the Guide prior art as well.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the search query system of Cossins et al. with the search engine syntax query method of utilizing the plus or minus query syntax as taught by Meta and/or Guide in order to include or exclude search items from the search query

for the well known purpose of allowing greater syntax options for broadening or narrowing a search query to more appropriately determine or identify search results requested. In short, it is clearly old and well known to provide specific syntax of the plus and minus sign to search through a query search.

**9. With respect to claims 8, 21, 34 and 47:**

Cossins et al. teaches a method for defining and identifying geographic areas performed by a computer system comprising a processor, a display device, and a memory encoded with program instructions that, when executed by the processor, cause the processor to perform the method, the method comprising the steps of:

providing for a geographic region wherein the geographic region is divided into states, and wherein the states are divided into postal codes;

receiving a query to identify a geographic area wherein the query comprises an indication of at least one of a set of states and a set of postal codes and outputting a response including information related to the geographic area (i.e. limitations similarly rejected under that of claims 1, 14, 27 and 40 for the proposition that the query may be by state and/or postal code where the results of the query is outputted to a map for display).

It appears that Cossins et al. fails to explicitly recite including in the query at least one of a plus sign and a minus sign, wherein the plus sign is included when at least one of the set of states and one of the set of postal codes is to be included in the geographic area and a minus sign is included when at least one of the set of states or one of the set of postal codes is to be excluded from the geographic region wherein the at least one of

the set of states and the set of postal codes preceded with a plus sign is included in the geographic area and the at least one of the set of states and the set of postal codes preceded with a minus sign is excluded from the geographic area.

However, Meta and Guide both teach search engine or search query syntax where common search syntax terms such as "and" or "not" are used interchangeably with a "plus sign" or a "minus sign" and are common to search term syntax when attempting to search for terms and exclude terms from a search. For example Meta teaches "THE PLUS SIGN: + A plus sign to designates a word that must be present in the document..." and "THE MINUS SIGN: - A minus sign designates a word that must not be present in the document." This is similarly taught and excepted in the Guide prior art as well.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the search query system of Cossins et al. with the search engine syntax query method of utilizing the plus or minus query syntax as taught by Meta and/or Guide in order to include or exclude search items from the search query for the well known purpose of allowing greater syntax options for broadening or narrowing a search query to more appropriately determine or identify search results requested. In short, it is clearly old and well known to provide specific syntax of the plus and minus sign to search through a query search.

**10. With respect to claims 9, 22, 35 and 48:**

The combination of Cossins et al. and Meta or Guide both teach the method of claims 8, 21, 34 and 47 respectively, wherein postal codes can be identified by at least

one number included in the postal code, starting with the first number of the postal code (i.e. via at least Cossins et al., at col. 20 lines 1-36, *passim* for the proposition that there are various descriptions of searching by state or postal code which represent query collections, wherein the postal code has at least one number associated with one number).

**11. With respect to claims 10, 23, 36 and 49:**

The combination of Cossins et al. and Meta or Guide both teach the method of claims 8, 22, 34 and 47 respectively, wherein the response includes a pictorial diagram wherein the identified geographic area is viewably different than those states and postal codes that are excluded from the geographic area (i.e. via Cossins et al., to include several interpretations such as coverage area regions at col. 15, lines 17-27; Figures 37-39 with descriptions for different shades of grey; and/or col. 10 lines 57- col. 11, line 4, *passim*, for the proposition that color representation is discussed throughout).

**12. With respect to claims 11, 24, 37 and 50:**

Cossins et al. teaches a method for defining and identifying a geographic area, comprising:

providing for a geographic region wherein the geographic region is divided into subregions that are mutually exclusive, and wherein the subregions are divided sections that are mutually exclusive (i.e. via the process of search query allowing for search by state, zip code, etc. as similarly rejected);

receiving a query for defining a geographic area wherein the query comprises an indication of at least one of a set of subregions and a set of sections (i.e. via at least col.

15 line 64 through col. 16 line or geocode searches specific to the "regions", *passim*), the indication comprises at least one symbol associated with at least one of reducing the number of subregions within the set of subregions, and reducing the number of sections with the set of sections (i.e. via at least col. 5 and 16 for the proposition that the generated maps have map based geographic elements such as stream "264" and/or network elements and/or performance elements, and/or geographic elements of the telecommunication system as shown in the Figures, for the proposition that any one of these elements contain "symbols" as the map is rendered);

However, it appears that Cossins et al. fails to explicitly recite including in the query at least one of a plus sign and a minus sign, wherein the plus sign is included when at least one of the set of subregions and one of the set of sections is to be included in the geographic area and a minus sign is included when at least one of the set of subregions or one of the set of sections is to be excluded from the geographic region.

However, Meta and Guide both teach search engine or search query syntax where common search syntax terms such as "and" or "not" are used interchangeably with a "plus sign" or a "minus sign" and are common to search term syntax when attempting to search for terms and exclude terms from a search. For example Meta teaches "THE PLUS SIGN: + A plus sign to designates a word that must be present in the document..." and "THE MINUS SIGN: - A minus sign designates a word that must not be present in the document." This is similarly taught and excepted in the Guide prior art as well.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the search query system of Cossins et al. with the search engine syntax query method of utilizing the plus or minus query syntax as taught by Meta and/or Guide in order to include or exclude search items from the search query for the well known purpose of allowing greater syntax options for broadening or narrowing a search query to more appropriately determine or identify search results requested. In short, it is clearly old and well known to provide specific syntax of the plus and minus sign to search through a query search.

**13. With respect to claims 12, 25, 38 and 51:**

The method of claims 11, 24, 37 and 50 respectively, wherein the subregions are states and the sections are postal codes (i.e. via Cossins et al., at least at col. 20 lines 1-36, *passim* for the proposition that there are various descriptions of searching by state or postal code which represent query collections).

**14. With respect to claims 13, 26, 39, 52:**

The method of claims 12, 24, 38 and 51 respectively, wherein sections can be identified by at least one number included in the postal code, starting with the first number of the postal (i.e. via at least Cossins et al., at col. 20 lines 1-36, *passim* for the proposition that there are various descriptions of searching by state or postal code which represent query collections, wherein the postal code has at least one number associated with one number).

***Response to Arguments***

15. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection. In addressing Applicant's newly amended language it is the Examiner's position that there are symbols associated with the subregions and sections as described and cited in the above rejections. In addressing Applicant's arguments with respect to the steps of "determining" it is the Examiner's position that the steps of determining are completed with the step of search inquiry. In short, a search query is performed specifically to determine what is to be included in a geographical rendering and what is to be excluded. The purpose of a map search of this nature is to include those geographical areas intended by the search criteria and exclude any geographic areas not within the search criteria. Therefore, it is the Examiner's position that these features are explicit if not inherent in the search feature of the prior art. Furthermore, it is precisely the geospatial data that is used to render the search criteria graphically and a determination of which areas and features to display is dependent on the search query. In addressing Applicant's arguments with respect to the rejections under 35 U.S.C. 103, the Examiner has explained the newly rejected claims *supra*, and maintains these rejections as well. In particular, the combination relies upon search engine syntax providing for the inclusion and exclusion of search criteria.

***Conclusion***

16. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571)

270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/  
Examiner, Art Unit 3629

/Traci L Casler/  
Primary Examiner, Art Unit 3629